

PATENT
Docket No. 00-8012RCE1
Application Serial No. 09/652,908

REMARKS

This amendment is responsive to an Office Action¹ having a mailing date of February 23, 2006. Claims 1-29 were presented for examination and were rejected. Claims 1, 9, 10, 18, 22, 26 and 29 are independent claims and each is currently amended. No new matter is added as explained below. No claims are canceled. No new claims are added. Claims 1-29 are pending.

Preliminarily, Applicants note that in the Office Action, page 2, claims 10, 15, 16, and 18-21 were rejected under 35 U.S.C. § 101 as allegedly being non-statutory. Applicants have amended claim 10 and have removed "carrier waves" from the specification in accordance with the Examiner's specific recommendations for the purpose of overcoming this rejection of these claims. Therefore, it is respectfully requested that this rejection of these claims be withdrawn.

Claims 1-7, 9-16, 18-22 and 25-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Birrell et al. (U.S. Patent No. 6,185,551, hereinafter "Birrell"). Claims 8, 17, 23 and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Birrell in view of Maurille (U.S. Patent No. 6,484,196, hereinafter "Maurille"). Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102 and 103 with regard to the claims as now amended.

For example, consider currently amended claim 1: "In a message arrival component, a personal messaging agent, comprising: a user profile configured to store user preferences for

¹ The Office Action may contain a number of statements characterizing the cited reference(s) and/or the claims which Applicants may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicants do not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicants deem allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicants that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

PATENT
Docket No. 00-8012RCE1
Application Serial No. 09/652,908

processing messages; a message filter configured to receive a message, perform in-band processing on the message based on the user preferences, and generate at least one event for triggering out-of-band processing of the message based on the user preferences; and at least one external helper configured to perform the out-of-band processing of the messages in response to the at least one event, wherein the user profile, the message filter and the external helper are created upon receipt of each one of the messages by the message arrival component." (Emphasis added.)

It is clear that claim 1 calls for, interalia, creating a personal messaging agent 220 (Applicants' Fig. 3) comprised of its user profile 310, its message filter 320 and its external helpers 330 upon receiving each one of the messages by the message arrival component 210 (Applicants' Fig. 2). This amendment is supported by Applicants' specification, as filed. For example:

"Fig. 3 is a detailed diagram of the PMA 220 according to an implementation consistent with the present invention. An instance of the PMA 220 may be created on a per message/per recipient basis (i.e., for each message placed in a specific recipient's mailbox 120). For example, a trigger may be generated upon receipt of a new message. The trigger may cause a process to execute that generates an instance of the PMA 220." (Specification, page 8, lines 13-17)

In other words, Applicants' PMA can be implemented in software outside of its server 112, where an instance of this software structure can be created on an as-needed basis, each time that a new email message arrives. This is not taught in Birrell.

In Birrell, with reference to its Figs. 1 and 2, mail service system 200 is a server that interfaces between a network, such as the Internet connected via link 249, and its clients connected via an HTTP bus. Applicants submit that server 200 is not "created" each time a

PATENT
Docket No. 00-8012RCE1
Application Serial No. 09/652,908

message is received over link 249, as there is nothing in Birrell to suggest that. Contained within server 200 are the various functions as shown in Fig. 2, such as the "add/remove label" which has been relied upon in the Office Action as representing an "out-of-band" activity. Applicants submit that the "add/remove label" functionality and any other of the functionality shown which may allegedly be related to applicants' "user profile", "message filter" and "external helper" is an integral part of server 200. Therefore, that functionality is not created each time a message is received because server 200 exists between email message arrivals. Indeed, there is nothing to the contrary disclosed or suggested in Birrell - server 200 operates with its clients 111, 112, 113 (Birrell, Fig. 1) and there is no suggestion in Birrell that this server is non-existent between email messages. Applicants submit that email servers typically do not operate in a mode of existence/non-existence as a function of each email message arrival.

Applicants' architecture is distinguished over Birrell, at least because Applicants' PMA is positioned outside of its message arrival server 112. Therefore, although Applicants' email server 112 may need to exist between arrivals of email messages because it is in communication with email sender 100 via a network, Applicants' PMA is not so constrained. "To the server 112, the PMA 220 behaves like the local delivery agent 114. To the local delivery agent 114, the PMA 220 acts like the server 112. This transparency makes it easy to integrate the functionality of the PMA 220 into any existing e-mail infrastructure." (See Specification, page 8, lines 6-9.) In other words, PMA 220 is transparent to both server and agent where it does not appear to exist at all! Therefore, it need not exist between messages, unlike a typical email server such as Birrell's server 200. To the extent that any of Birrell's functionality can be reasonably mapped to the elements of Applicants' claim 1, and Applicant does not acquiesce in any such mapping, the

PATENT
Docket No. 00-8012RCE1
Application Serial No. 09/652,908

Birrell reference shall still be inadequate to anticipate Applicants' claim 1 at least because any such functionality residing in mail server system (server) 200 is not characterized as being created on a per message basis as expressly called-for in Applicants' claim 1.

MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." See *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). In this instance, the claim limitation "wherein the user profile, the message filter and the external helper are created upon receipt of each one of the messages by the message arrival component" is not disclosed or suggested by Birrell. Maurille, cited for purposes of teaching that the external helper is configured to generate a reply to the message, etc., does not cure this deficiency in Birrell. Therefore, the 35 U.S.C. § 102(e) rejection of claim 1 should be withdrawn and the claim allowed.

The other independent claims have been similarly amended and contain similar limitations.

Claim 9 recites, interalia: "wherein the system is created upon each receipt of the at least one message." Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 9 should be withdrawn and the claim allowed.

Claim 10 recites, interalia: "wherein the in-band processing, the event generating and the out-of-band processing are created upon receipt of each message in the message stream."

BEST AVAILABLE COPY

PATENT

Docket No. 00-8012RCE1

Application Serial No. 09/652,908

Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 10 should be withdrawn and the claim allowed.

Claim 18 recites, interalia: "wherein the method is created upon receipt of the each received message in the message stream." Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 18 should be withdrawn and the claim allowed.

Claim 22 recites, interalia: "wherein one of the plurality of personal messaging agents is created each time a message in its respective one of the plurality of message streams is received by the message arrival system;" Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 22 should be withdrawn and the claim allowed.

Claim 26 recites, interalia: "wherein the personal messaging agent is created upon receipt of the e-mail message by the server" Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 26 should be withdrawn and the claim allowed.

Claim 29 recites, interalia: "wherein capability for the in-band and out-of-band processing of each email message is created upon receipt of the each email message" Therefore, for reasons similar to those given above, the 35 U.S.C. § 102(e) rejection of claim 29 should be withdrawn and the claim allowed.

Claims 2-8, dependent directly or indirectly from allowable claim 1, are also allowable, at least for reasons based on their dependency from an allowable base claim.

Claims 11-17, dependent directly or indirectly from allowable claim 10, are also allowable, at least for reasons based on their dependency from an allowable base claim.

Claims 19-21, dependent directly or indirectly from allowable claim 18, are also allowable, at least for reasons based on their dependency from an allowable base claim.

PATENT

Docket No. 00-8012RCE1

Application Serial No. 09/652,908

Claims 23-25, dependent directly or indirectly from allowable claim 22, are also allowable, at least for reasons based on their dependency from an allowable base claim.

Claims 27-28, dependent directly or indirectly from allowable claim 26, are also allowable, at least for reasons based on their dependency from an allowable base claim.

PATENT
Docket No. 00-8012RCE1
Application Serial No. 09/652,908

CONCLUSION


In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Verizon Corporate Services Group Inc.

By:


Joel Wall
Reg. No. 25,648

Date: May 23, 2006

600 Hidden Ridge, HQE03H14
Irving, Texas 75038
(972) 718-4800

Customer No. 32127

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being transmitted by facsimile to the United States Patent Office at 571-273-8300.

Dated: May 23, 2006


Signature (Christian R. Andersen)